

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-5, 11 and 16-18 are rejected under 35 U.S.C. 102(b) over the patent to Larson.

Claims 1-11 and 13-18 are rejected under 35 U.S.C. 102(b) over the patent to MacKay.

Claims 1, 3-6 and 11-17 are rejected under 35 U.S.C. 102(b) over the patent to Block.

Also, claim 7 is rejected under 35 U.S.C. 112.

In connection with the Examiner's rejection of the claims, applicants have cancelled claims 11 and 13 and amended claim 1 by introducing into them the features of the cancelled claims with an additional feature that the second element is designed for immobilizing the application tool with a spring force.

When the tool receiver is designed in accordance with the present invention, it is possible to provide a clearance-free securing of the application tool, an advantageous functional separation of an axial securing and a securing in a circumferential direction on the application tool side and on the machine side, so that the elements can be designed in correspondence with these requirements, completely without a functional intersection of the elements, which is new, unobvious and highly advantageous a patentable feature of the present invention.

In the patent to Wiley there is no hint or suggestion to provide immobilization of the application tool in an axial direction with a spring force. Moreover, the patent to Willy teaches that the component 38 with a projection 60 is limited in an axial direction and in a circumferential direction with respect to its movement relative to the component 36, as explained in column 4, lines 15-26.

Furthermore, neither the patent to Larson nor the patent to Block '467 provides any hint or suggestion for such a functional separation. In the patent to MacKay '972 an adjusting screw 52 is used to guide a pin 42 against a spring force of a spring 43 in a recess 51 of a closing plate 45, which however does not provide a detent of an arresting element for positive

immobilization. The same is true with respect to the patents to Larson and Block.

The above discussed references do not teach the above mentioned new features of the present invention. Also, these features can not be considered as obvious, since the functional separation of an axial immobilization and immobilization in a circumferential direction, a clearance-free immobilization in an axial direction, etc., are not disclosed in the references and can not be derived from them as a matter of obviousness.

In view of the Examiner's rejection of the original claims as being anticipated by the above discussed references, it is believed to be advisable to cite the following decisions on this issue.

As decided in *Lindenman Maschinenfabrik GmbH v. American Hoist and Dairy Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984):

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

In the decision *Motorola, Inc. v. Interdigital Tech Corp.* 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997), it was stated:

"For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its resistance in the prior art".

In Row v. Dror 42 USPQ 2d 1550, 1553 (Fed. Cir. 1997) it was stated:

"A prior art reference anticipates a claim only if the reference discloses, even expressly or inherently, every limitation of the claim. Absence from the reference of any claimed element negates anticipation."

Definitely, the rejection of the original claims as being anticipated by the references should be considered as no longer tenable with respect to the amended claim 1.

Also, as explained herein above, the present invention provides for the highly advantageous results which can not be accomplished by the solution disclosed in the references. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case Ex parte Tanaka, Marushima and Takahashi (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no

suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that claim 1 should be considered as patentably distinguishing over the art and should be allowed.

Claim 19 defines that the second element is supported movably and loaded by a spring element. None of the references, including the patents to Block, MacKay, Willy, discloses an element for an axial immobilization or an axial detent element which is movable against a spring element. In the patent to Larson a pin 17 is supported movably, while in the elements 21 which serve directly for the axial immobilization are held immovably in a ring 13. By the movable support of the second element in accordance with the present invention, an advantageous, exact immobilization in the axial direction can be provided, and in particularly advantageous and simple manner the application tool can be loaded in the axial direction axially with a desired spring force. In operation, the axial forces thereby do not act against the spring force, so that during the operation a lifting of the application tool opposite to the spring force from an abutment surface and thereby a clearance can be advantageously avoided.

It is therefore believed that the new features of the present invention defined in claim 19 are also not disclosed in the references and this claim should be considered as patentably distinguishing over the art.

Claim 20 defines that the second element is movable and is designed with a holding surface so that with the holding surface of the second element the application tool is loaded in an axial direction from the free end of the drive shaft to the machine-side end of the drive shaft against a machine-side abutment surface with a spring force of a spring element.

Claim 21 defines that the second element is supported movably and loaded by a disc spring element.

None of the references teaches these features of the present invention, in particular a disc spring element for loading an element which serves for an axial immobilization of an application tool. Such a construction provides an advantage in that the disc spring element has a flat or space-economical construction.

Claim 22 defines that the application tool in the operating position is connected in an axial direction through at least two second

elements. With this reduction of construction mounting expenses and costs with simultaneous space-economical construction are provided.

Claim 23 defines also new features of the present invention. None of the references, including the patents to Willy, Block, MacKay, Larson disclose such a tool with a corresponding hub as defined in this claim. The patent to Willy discloses the application tool 26 with only one recess shown in Figure 4, for immobilization in an axial direction and in a circumferential direction. The patent to Block discloses a ring 22 of the application tool with three recesses 56, which serve correspondingly exclusively for immobilization, as shown in Figure 3. The patent to Larson discloses the application 230 with three recesses 37, each serving for immobilization in a circumferential direction and in an axial direction as shown in Figure 2. The patent to MacKay discloses the application tool 17 which also has three recesses 20 each for immobilization in a circumferential direction and in an axial direction as shown in Figure 1.

The advantage of the applicant's invention is the functional separation of the recesses for performing their corresponding functions. Undesirable alternating actions during the operation can be reliably avoided.

Finally, claim 24 defines that the hub has a third recess for centering, which is separate from the first and the second recesses.

With this construction, in a structural a simple and cost-favorable manner, an especially exact receptacle of the tool can be obtained.

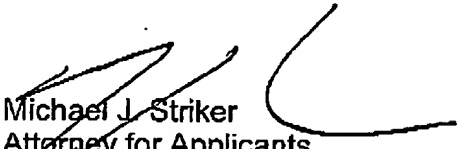
The above mentioned additional claims define solutions which are not disclosed in the references and therefore can not be anticipated by the references, and the references do not contain any hint or suggestion that such features can be provided in the references, and also these features provide for the highly advantageous results which can not be accomplished by the construction disclosed in the references. It is therefore believed that these claims should also be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 1, ~~they~~ share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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